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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,691	07/20/2001	Lester E. Cornelius	65144/6	2552
7590 01/05/2004			EXAMINER	
Craig J. Arnold Amster, Rothstein & Ebenstein 90 Park Avenue New York, NY 10016			FEELY, MICHAEL J	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 01/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/910,691

Applicant(s)

CORNELIUS ET AL.

Examiner

Michael J Feely

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,7-46 and 65-84 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3,5,7-19,27-31,34-39,43-46,65,66,69-79 and 81-83 is/are allowed.
- 6) ☒ Claim(s) 20-26,32,33,40-42,67,68,80 and 84 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 0903 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Pending Claims***

1. Claims 1-3, 5, 7-46, and 65-84 are pending.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. The previous rejection of claims 5 and 6 under 35 U.S.C. 112, second paragraph, has been overcome by amendment.

4. Claims 20-26, 32, 33, 38, 40-42, 67, 68, 80, and 84 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 recites the limitation "the layer farthest from the substrate" in UV block material according to claim 7. There is insufficient antecedent basis for this limitation in the claim. The material of claim 7 only has one layer provided on the substrate. Claim 41 is rejected because it is dependent from claim 20.

Claims 21-26, 32, 33, 67, 68, 80, and 84 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: embodiment (b) of independent claim 21 must contain an ultraviolet radiation absorber – see page 27, laminate 2, of the Specification.

Claims 38 and 40 include the language, "wherein an image is formed by an ink jet recording system or a thermal transfer printing system on the surface of the material to be

transferred *with the ultraviolet block layer of the ultraviolet block material,*” and “wherein an image is formed by an ink jet recording system or a thermal printing system on the surface of the material to be layered *with the ultraviolet block material.*” It is unclear if the UV block layer or the UV block material is doing the image forming or the transferring/layering. It is also unclear when the image formation is taking place in the process sequence of forming the laminate.

Claim 42 recites the limitation “a color material-receiving layer on the ultraviolet block material of claim 36” in the method for the protection of a material to be adhered. There is insufficient antecedent basis for this limitation in the claim. This issue could be alleviated by inserting the phrase --color material-receiving-- before the phrase, “layer that has received” in claim 36.

#### ***Claim Language Suggestions***

5. To improve the consistency of the claim language, it is suggested that the phrase “the layer comprising the fluorescent material” be substituted with --the layer comprising the fluorescent material, ultraviolet radiation absorber and stabilizer-- in claims 13-16 and 19.
6. To improve the consistency of the claim language, it is suggested that the phrase “the layer comprising the fluorescent material” be substituted with --the layer comprising the fluorescent material, ultraviolet radiation absorber and stabilizer-- in claims 27-31 and 35.
7. To improve the representation of claim 46, is suggested to replace the claim with --The product produced according to the method of claim 5--.

#### ***Allowable Subject Matter***

8. Claims 1-3, 5, 7-19, 27-31, 34-39, 43-46, 65, 66, 69-79, and 81-83 are allowed.

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9. Claims 20-26, 32, 33, 40-42, 67, 68, 80, and 84 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter: Applicant has successfully incorporated the previously indicated allowable subject matter into independent claims.

***Communication***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Feely whose telephone number is 571-272-1086. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Michael J. Feely  
Patent Examiner  
Art Unit 1712

December 29, 2003